

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. Claims 1, 8-18, 32-53, 63, 64 and 66-74 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed. For purposes of 101, a "process" has been given a specialized, limited meaning by the courts.

Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (In re Bilski, Appeal No. 2007-1130), a 101 process must 1) be tied to another statutory class (such as a particular apparatus) or 2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

Claims 1, 8-18, 32-53, 63, 64 and 66-74 are drawn to a method for determining multiple fulfillment plans for delivering an item. All of the recited method steps can be performed in the mind of the user and therefor the method steps are not tied to another statutory class, and do not transform the underlying subject matter.

The second step is to determine whether the claimed invention falls within a judicial exception (law of nature, natural phenomena, or abstract idea), whether the invention produces a useful, concrete, and tangible result.

In the present case, Claims 1, 8-18, 32-53, 63, 64 and 66-74 only recite an abstract idea. The claims recite a method which comprises the steps of receiving an indication of an item, determining multiple distribution centers which can supply the item, determining multiple plans for supplying the item, and presenting the multiple fulfillment plans to the user. The steps only constitute method which can be done with the mind of the user, or written down on paper. No other, therefore an abstract idea.

Additionally, for a claimed invention to be statutory, the claimed must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces multiple distinct fulfillment plans, however is not considered to be concrete and tangible, because the claims constitute an abstract idea. The claims are not drawn to something that is concrete and tangible, therefore deemed to be an abstract idea and is not considered to be patent eligible subject matter.

2. Claims 59-62 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. Claim 59 is drawn to a device, which appears to fall into statutory class of a “machine”, however does not recite any structure of the device itself. Claim 59 recites components, however the claimed components are software programs which perform certain

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functions. Therefore no real structure is recited for the device itself. Claim 62 is drawn to a system with "means for" performing certain steps, again this claim appears to fall into the "machine" statutory class, however the "means for" are software programs which perform certain tasks. Claim 62 fails to disclose any structure to the system. Therefore Claims 59-62 do not fall within any of the 4 statutory classes.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 7-19, 32-74, 77 and 79-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carmax (www.carmax.com) in view of Bilibin et al. (US 2005/0197892).

6. With respect to Claim 1, 63, 67, 72, 73, 74, 77, 81, 82: Carmax discloses the use of a method and system for providing multiple fulfillment plans for an item (See Page 2) comprising:

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- a. Before receiving from a customer of the item ordering service a request to obtain information about an ordering process for one or more items (this is done while searching (see Page 9);
- b. Automatically determining multiple geographically distributed item distribution centers that are maintained by the item ordering service and that are each available as an alternative to supply the items (Page 2, Paragraph 3);
- c. Automatically determining multiple distinct alternative fulfillment plans for supplying the items to the customer that are each associated with one of the determined item distribution centers such that each of the determined item distribution centers has at least one associated fulfillment plan, each fulfillment plan indication that the item are to be shipped from the item distribution center associated with the fulfillment plan and indicating a manner of shipping the items from the associated item distribution center to the customer and indicating information about processing that would take place at the associated item distribution center as part of the fulfillment plan to prepare the items for the shipping to the customer (See Page 3, Transfer of Cars)
- d. For multiple determined distinct fulfillment plans
 - i. Determine a cost of use for that fulfillment plan if the items are supplied using that fulfillment plan (Page 8);
 - ii. Determining delivery information for that fulfillment plan on which the customer will receive the items if the items are supplied using that fulfillment plan, the determined delivery information being based at least in part on the indicated manner of shipping the items for that fulfillment plan and being based at

least in part on the indicated information about the processing that would take place at the associated item distribution center for that fulfillment plan (See Page 8).

- e. Providing to the customer an indication of each of the multiple of the determined fulfillment plans as options for supplying the items to the customer, each indication of a determined fulfillment plan option including the determined cost of use and the determined actual delivery date of that determined fulfillment plan option (see Page 9 and Page 2, Paragraph 3, CarMax returns the car that is searched at the location of choice, as well as the car that is in inventory at other surrounding stores and displays all results for the user to purchase, and for the user to transfer even before purchasing the car)
 - f. After an indication from the customer to use a selected one of the indicated determined fulfillment plan options as part of an order for the items, indicating to place the order for the items using the selected fulfillment plan so that the customer will receive options for how an order is to be fulfilled one will receive accurate delivery date information for the order prior to the order placement (See Page 7, shopping online).
7. CarMax discloses the use of providing a table of delivery information and how long it takes for delivery, however fails to disclose specifically determining an actual delivery date, and providing the actual delivery date to the customer. Bilibin discloses a method and system for shipping an item, where the actual delivery date is determined and provided to the customer with the multiple fulfillment plans (See Figure 36A with corresponding detailed description). Carmax discloses a database which can be used to determine an actual delivery date, Bilibin discloses a database/ rate structure which IS used to calculate an actual delivery date. It would have been

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obvious to one having ordinary skill in the art at the time the invention was made to apply the technique of determining the actual delivery date of Bilibin to the system of CarMax, for the predictable result of giving the customer as much information as possible to make an informed decision. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

8. With respect to Claim 7, 65 and 84: CarMax discloses everything is done over a website (www.carmax.com).

9. With respect to Claim 8: CarMax discloses the transferring of vehicles, therefore the examiner considers this to be describing how it will be performed.

10. With respect to Claims 9-11 and 68: CarMax discloses the search being done from one location (See Figure 9), which the examiner considers this to be the default setting and the preferred location.

11. With respect to Claim 13: CarMax discloses the amount of time it takes to transfer the item (Page 8), Bilibin discloses determining an actual delivery date (Paragraph 0218 and 0221).

12. With respect to Claim 14 and 37-41: CarMax discloses the use of a transfer cost (See Page 8) and Bilibin discloses the determining of the cost of use for a fulfillment plan includes:

g. modeling at least some future costs of supplying expected future orders to recipients if the indicated items are supplied to the recipient using the fulfillment plan (Paragraph 0287 shipping cost, the examiner considers them to be future cost, cause the item has not been purchased yet);

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- h. determining at least some of multiple costs that are directly attributable to using the fulfillment plan to supply the items to the recipient (Paragraph 0287);
 - i. assigning costs to at least some of one or more reductions in customer goodwill that result from using the fulfillment plan to supply the items to the recipient (Paragraph 0295, see discounts); and
 - j. totaling the modeled future costs, the determined directly attributable costs, and the assigned customer goodwill reduction costs (Paragraph 0295).
13. With respect to Claim 64: CarMax discloses after searching the car can be transferred or purchased online (Pages 3 and 7). The examiner considers this to be a “potential order”.
14. With respect to Claims 66 and 83: CarMax discloses that a search is done, and from the results a car can be selected, the examiner considers this to be presenting a control to the customer (See Page 2).
15. With respect to Claims 69 and 70: CarMax discloses part of the purchase can be done online, and then you visit a store to pick up your vehicle and complete the paperwork. Therefore at that time, information on the order is provided before the provisional date. (See Page 7).
16. With respect to Claim 71 and 80: See CarMax, Page 8.
17. With respect to Claim 79: Bilibin discloses a time associated with the delivery date (See Figure 36A).
18. With respect to Claim 85: See Bilibin Figure 36A.
19. With respect to Claim 86: Bilibin discloses the medium is data transmission of a data signal (Paragraph 0173).

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20. With respect to Claim 87: Bilibin discloses the medium is memory in a computer device (Paragraph 0122).

21. With respect to Claims 15: CarMax and Bilibin disclose the use of fulfillment plans, however fail to disclose the fulfillment plans including processing lanes. However, the information in the fulfillment plan including processing lanes is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps of providing the delivery fulfillment plans and indicating the fulfillment plans, would be performed the same regardless of whether the plans included the processing lanes due to the fact that no further steps use the information on the processing lanes for any other reason. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

22. With respect to Claims 16, 35, 46, 49, 52-55, 58, 59 and 62: Carmax discloses the use of a method and system for providing multiple fulfillment plans for an item (See Page 2) comprising:

k. Before receiving from a customer of the item ordering service a request to obtain information about an ordering process for one or more items (this is done while searching (see Page 9);

l. Automatically determining multiple geographically distributed item distribution centers that are maintained by the item ordering service and that are each available as an alternative to supply the items (Page 2, Paragraph 3);

- m. Automatically determining multiple distinct alternative fulfillment plans for supplying the items to the customer that are each associated with one of the determined item distribution centers such that each of the determined item distribution centers has at least one associated fulfillment plan, each fulfillment plan indication that the item are to be shipped from the item distribution center associated with the fulfillment plan and indicating a manner of shipping the items from the associated item distribution center to the customer and indicating information about processing that would take place at the associated item distribution center as part of the fulfillment plan to prepare the items for the shipping to the customer (See Page 3, Transfer of Cars)
- n. For multiple determined distinct fulfillment plans
 - iii. Determine a cost of use for that fulfillment plan if the items are supplied using that fulfillment plan (Page 8);
 - iv. Determining delivery information for that fulfillment plan on which the customer will receive the items if the items are supplied using that fulfillment plan, the determined delivery information being based at least in part on the indicated manner of shipping the items for that fulfillment plan and being based at least in part on the indicated information about the processing that would take place at the associated item distribution center for that fulfillment plan (See Page 8).
- o. Providing to the customer an indication of each of the multiple of the determined fulfillment plans as options for supplying the items to the customer, each indication of a determined fulfillment plan option including the determined cost of use and the

determined actual delivery date of that determined fulfillment plan option (see Page 9 and Page 2, Paragraph 3, CarMax returns the car that is searched at the location of choice, as well as the car that is in inventory at other surrounding stores and displays all results for the user to purchase, and for the user to transfer even before purchasing the car)

p. After an indication from the customer to use a selected one of the indicated determined fulfillment plan options as part of an order for the items, indicating to place the order for the items using the selected fulfillment plan so that the customer will receive options for how an order is to be fulfilled one will receive accurate delivery date information for the order prior to the order placement (See Page 7, shopping online).

23. CarMax discloses the use of providing a table of delivery information and how long it takes for delivery, however fails to disclose specifically determining an actual delivery date, and providing the actual delivery date to the customer. Bilibin discloses a method and system for shipping an item, where the actual delivery date is determined and provided to the customer with the multiple fulfillment plans (See Figure 36A with corresponding detailed description). Carmax discloses a database which can be used to determine an actual delivery date, Bilibin discloses a database/ rate structure which IS used to calculate an actual delivery date. It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the technique of determining the actual delivery date of Bilibin to the system of Carmas, for the predictable result of giving the customer as much information as possible to make an informed decision. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

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24. CarMax discloses providing a listing of the fulfillment plans, however fails to disclose selecting one of the fulfillment plans, at least based on cost and provide the information to the customer about the selected one. Bilibin discloses an embodiment where the best price or the best date can be used to select one of the multiple shipping plans for a carrier (See Figure 36f with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to apply the technique of Bilibin of having the option of automatically selecting one of the fulfillment plans, to the system of CarMax, for the predictable result of allowing a customer to choose what is more important to them such as least cost or fastest processing and making sure all the results meet the customers needs. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

25. With respect to Claims 17 and 18: CarMax discloses after searching the car can be transferred or purchased online (Pages 3 and 7). The examiner considers this to be a “potential order” and are done to initiate an order.

26. With respect to Claims 19 and 34: See www.carmax.com.

27. With respect Claims 32, 33, 36, 44 and 61: See Bilibin, Figure 36A with corresponding detailed description.

28. With respect to Claim 42: CarMax discloses that a search is done, and from the results a car can be selected, the examiner considers this to be presenting a control to the customer (See Page 2).

29. With respect to Claim 43: Bilibin discloses the use of fulfillment plans, however fail to disclose the fulfillment plans including processing lanes. However, the information in the

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fulfillment plan including processing lanes is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps of providing the delivery fulfillment plans and indicating the fulfillment plans, would be performed the same regardless of whether the plans included the processing lanes due to the fact that no further steps use the information on the processing lanes for any other reason. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

30. With respect to Claim 45: Bilibin discloses the use of an indication of priority of the items (Paragraph 0456).

31. With respect to Claims 47 and 48: Carmax discloses the use of ordering online (See Page 7) and discloses the transferring location being the default search location, used to search the inventory (Page 9).

32. With respect to Claim 50: See CarMax, Page 8.

33. With respect to Claim 51: See CarMax Page 6.

34. With respect to Claims 56 and 60: Bilibin discloses the medium is memory in a computer device (Paragraph 0122).

35. With respect to Claim 57: Bilibin discloses the medium is data transmission of a data signal (Paragraph 0173).

Response to Arguments

36. Applicant's arguments with respect to claims 1, 7-19, 32-74, 77, 79-87 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629

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